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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,235	01/13/2000	John L. Wood	OCR-729/756	6715

7590 03/20/2002
Mary M Krinsky
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/20/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,235

Applicant(s)

WOOD et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 4, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claims 1-20 are pending in the application.

This action is in response to applicants' amendment dated January 4, 2002. Claims 1 and 17 have been amended.

Priority

1. It is recognized benefit under 35 U.S.C. § 120 is being urged. However, instant application is only entitled to benefit of serial number 09/206,082 filed December 4, 1998. Application Serial Number 09/482,235 is a divisional of Wood et al. U.S. Serial Number 09/206,082 filed December 4, 1998 now U.S. Patent Number 6,037,468; which is a CIP of U.S. Serial Number 08/817,230 filed June 4, 1997 now abandoned; as the U.S. national phase entry under 35 U.S.C. § 371 of PCT/IB96/00987, which had an international filing date of August 9, 1996, claiming benefit of U.S. application serial number 60/002,164 filed August 11, 1995. While it is noted that the instant application is entitled to the December 4, 1998 date, they are not entitled to the filing date of the application U.S.S.N. 08/817,230. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 U.S.C. § 120. Applicants are ignoring the compliance of 112 first paragraph in that the **entire claim(s) of the instant invention must be describe in the parents in order to get benefit under 35 U.S.C. 120.**

2. The amendment to the abstract is acknowledged.

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3. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 6-8, 10-12, 18 and 19 in the last office action, the applicants' arguments have been fully considered but are not found persuasive. The applicants' stated that "support for the specific R groups may be found in the specification on pages 14, 15, 17, 21 and 22". The reaction Schemes on pages 14, 15, 17 21 and 22 are directed to the process of preparing specific species and do not represent a genus. For example in Scheme XII on page 15, the compounds of formula 30 are such that the definition of R is only associated with the R attached to the 2-oxopyrrole ring. Scheme XV on page 17 fails to define R of formula 28c. Scheme XX on page 21 only defines R for the compounds of formula 51 and 52 for which there is no claim. Hence, the definition of R where R is methyl, CO_2CH_3 , dimethoxybenzyl, paramethoxybenzyl or benzyl is not defined in the specification with respect to the genus.

Claims 6-8, 10-12, 18 and 19 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For reasons of record and stated above.

4. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 1-20 of the last office action which are hereby **withdrawn**.

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5. With regards to the 35 U.S.C. § 102 rejections of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicant's arguments are on the basis that the Tetrahedron Letter paper and the J.A.C.S. paper are not prior art. It is recognized benefit under 35 U.S.C. 120 is being urged. However, instant application is only entitled to benefit of serial number 09/206,082 filed December 4, 1998 as it is only completely described in this application. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 U.S.C. 120. Only 09/206,082 completely describes the invention of this application serial number 09/482,235, the applicant's earliest priority document does not. Note for benefit under 35 U.S.C. 120, there must be clear support (description and enablement) for claims instantly rejected herein as was set forth in *In re Scheiber* 199 USPQ 782; *In re Lukach*, 169 USPQ 795; *In re Gostelli*, 10 USPQ 2nd 1614; *Kawai v. Metlesics* 178 USPQ 159.

Claims 6-8 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of the American Chemical Society and Tetrahedron Letters. For reasons of record and stated above.

In view of the amendment dated January 4, 2002, the following new grounds of rejection apply:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10, 17, 18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the definition of X where X is S and/or O in the formula on the right at the top of page 3 and the bottom of page 4 are not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

7. Claims 1-10, 13-18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the definition of R where R is Me, CH₂OH, CO₂Me, Bn, DMB and PMB are not described in the specification for the genus. While the reaction Schemes pointed out by the applicants indicate that specific R moieties of the formulae may be Me, CH₂OH, CO₂Me, Bn, DMB and PMB, not every R moiety is.

Applicant is required to cancel the new matter in the reply to this Office action.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

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- a) Regarding claims 1 and 17, the phrase "including" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- b) Claim 8 recites the limitation "where the oxo group is bonded to the left of the N atom" in the right hand structure at the top of page 27. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

9. Claims 6 and 18 are objected to because of the following informalities: the substituent OH appears twice in the definition of R. Appropriate correction is required.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
March 19, 2002